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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,910	08/06/2001	Donald F. Gordon	SEDN/I13CON2	9300

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EXAMINER
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SHANG, ANNAN Q

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/922,910

Applicant(s)

GORDON ET AL.

Examiner

Annan Q. Shang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/19/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 11/19/07 have been fully considered but they are not persuasive.

With respect to claims 1-19, rejected under 35 U.S.C. 103(a) as being unpatentable over **Knudson et al (6,016,141)** in view of **Hendricks et al (6,201,536)**, applicant discusses the prior arts of record and the claimed invention and argues that the prior arts do not teach the claim limitations, i.e., fails to teach or suggest "...at least the providing a set of more than two on-demand programs..." that "...packaging the set into a subset having at least two on-demand programs of the set of on-demand programs..." etc., (see pages 5 of 8+ of Applicant's Remarks).

In responses, Examiner notes Applicant's arguments, however, the Examiner disagrees. Knudson teaches a server (MF/TV-DF 22/26) which provides a set of more than two programs; packaging the set into a subset having at least two programs (fig.1 col.3, lines 9-21 and col.4, line 22-col.5, line 16), provides a user interface (figs.2 and 7-9, col.4, lines 16-col.5, line 16) having the subset as a selectable object, the user interface configured to allow selection of the selectable object representing the subset of at least two programs to be purchased as a package for on-demand access (fig.6, col.4, line 38-col.5, line 30, line 52-col.6, line 57 and col.7, line 5-59) and further discloses making programs available for impulse purchasing and offering multiple packages of programs (near video-on-demand (NVOD), PPV, etc.,) to subscribers for purchasing on a daily, weekly, monthly, etc., Although Knudson teaches NVOD, PPV,

IPPV, et., Knudson is silent as to VOD. However, in the same field of endeavor, **Hendricks** discloses network manager for cable TV system Head-ends, which provides program packages, IPPV, NVOD, VVOD, VOD, etc., upon request from subscribers (figs.1-8, col.6, lines 56-65, col.4, line 1-14, col.8, line 8-col.9, line 38 and col.18, line 1-col.19, line 1+). Hence, the 103(a) rejection is proper, meets all the claim limitations, maintained as repeated below.

As to applicant arguments as to "The test under...103 is...would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious...", Examiner maintains that, the test for obviousness is not whether the features of a secondary reference may be bodily incorporate into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In this case all references are in the same field of endeavor as such combining the teaching of Knudson with Hendricks would be within the knowledge of one of ordinary skill in the art, and appropriate motivation was given.

Furthermore it appears Applicant's arguments are directed against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. **See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).**

In view of the above, the combination of Knudson and Hendricks is proper and maintained as repeated below. **This Office Action is made FINAL.**

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knudson et al (6,016,141)** in view of **Hendricks et al (6,201,536)**.

As to claim 1, note **Knudson** reference figures 1-11 discloses interactive TV program guide system with pay program package promotion and further discloses an interactive information distribution system containing service provider equipment and subscriber equipment (set-top terminal) that is interconnected by a communications network, the method of providing a subscription-on-demand service, comprising:

(MF/TV-DF 22/26) providing a set of more than two programs; packaging the set into a subset having at least two programs (fig.1 col.3, lines 9-21 and col.4, line 22-col.5, line 16).

Providing a user interface (figs.2 and 7-9, col.4, lines 16-col.5, line 16) having the subset as a selectable object, the user interface configured to allow selection of the selectable object representing the subset of at least two programs to be purchased as a

package for on-demand access (fig.6, col.4, line 38-col.5, line 30, line 52-col.6, line 57 and col.7, line 5-59).

Knudson teaches making programs available for impulse purchasing and offering multiple packages of programs (near video-on-demand (NVOD), PPV, etc.) to subscribers for purchasing on a daily, weekly, monthly, etc., basis, but fails to explicitly teach providing VOD or on-demand program services.

However, **Hendricks** discloses network manager for cable TV system Head-ends, which provides program packages, IPPV, NVOD, VVOD, VOD, etc., upon request from subscribers (figs.1-8, col.6, lines 56-65, col.4, line 1-14, col.8, line 8-col.9, line 38 and col.18, line 1-col.19, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Hendricks into the system of Knudson to include VOD service in addition to the other services, and offer purchasable promotional packages of VOD or on-demand programs to the subscriber on subscription basis.

As to claims 2-7, Knudson further discloses where in response to selection of the selectable object representing the subset of the at least two programs causing subscription to the programming package, providing a time limited access period to the subset of at least two programs without incurring an additional fee, providing a time limited to access period to the subset of the at least two programs, subscription to the package at a predefined price, where the predefined price is one-time access fee and where the one-time access fee has time-limited period of access (fig.6, col.5, line 17-col.6, line 57 and col.7, line 5-59).

As to claims 8-19, Knudson further discloses programming package where the programming packages are arranged in a hierarchical package of programming, comprising multiple program packages including a top level package including all of the at least two programs and at least one particular package including only a portion of the at least on-demand programs, one particular package with respective portion of at least two programs, defined according to content categories comprises one or more sports, particular teams, etc., (col.6, line 5-35) to enable a user to select from an object representing a top level of hierarchical package programming, user defined program package to enable personal subscription service, causing subscription of the programming packages upon selections of the objects for predefined price for predefined time period and where the SOD service provides the content subsets at a predefined price for a predefined time period (fig.6, col.5, line 17-col.6, line 57 and col.7, line 5-59).

Knudson fails to explicitly teach providing VOD or on-demand program services.

However, **Hendricks** discloses network manager for cable TV system Head-ends, which provides program packages, IPPV, NVOD, VVOD, VOD, etc., upon request from subscribers as discussed above with respect to the rejection of claim 1.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

**Annan Q. Shang.**